

**REMARKS/ARGUMENTS**

**Restriction**

Restriction to one of the following inventions has been required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method of extending survival and/or delaying disease progression of a human tumor in a mammal by administering antibody with identifying characteristics of PTA-5691, classified in Class 424, subclass 130.1.
- II. Claims 9-16, drawn to monoclonal antibody PTA-5691 and the clone deposited as PTA-5691, classified in Class 435, subclass 326, Class 530, subclass 387.1.
- III. Claims 17-20, drawn to a method of screening/detecting the presence of cancerous cells in a tissue sample from a human tumor with antibody PTA-5691, classified in Class 435, subclass 7.1.
- IV. Claims 21-28, drawn to antibody PTA-5690 and the clone deposited as PTA-5690, classified in Class 435, subclass 326, Class 530, subclass 387.1.
- V. Claims 29-32, drawn to a method of screening/detecting the presence of cancerous cells in a tissue sample from a human tumor with antibody PTA-5690, classified in Class 435, subclass 7.1.

The Examiner has also required the following election of species:

Group I is further subject to election of a single disclosed species comprising antibody conjugates wherein the conjugated moieties have different structures and functions wherein the moieties are (a) cytotoxic moieties, (b) enzymes, (c) radioactive compounds, and (d) hematogenous cells, contemplated in the specification.

Group II is further subject to election of a single disclosed species comprising antibody conjugates wherein the conjugated moieties have different structures and functions wherein the moieties are (a) cytotoxic moieties, (b) enzymes, (c) radioactive compounds, and (d) hematogenous cells, all of claim 15.

Group IV is further subject to election of a single disclosed species comprising antibody conjugates wherein the conjugated moieties have different structures and functions wherein the moieties are (a) cytotoxic moieties, (b) enzymes, (c) radioactive compounds, and (d) hematogenous cells, all of claim 27.

#### **Election**

Applicants herein elect, without traverse, Group IV (claims 21-28) for prosecution on the merits. Additionally, Applicants herein elect, with traverse, the species "cytotoxic moieties".

**Status of Claims/Support for Amendments**

Claims 21-28 have been elected for prosecution on the merits. Claims 1, 8-11, 14, 16-17, 19, 21-23, 26, 28-29, and and 31 have been amended. Claims 1-20 and 29-32 are withdrawn from consideration. It is understood that claims 1-20 and 29-32, drawn to the non-elected inventions, will remain pending, albeit withdrawn from consideration on the merits at this time. Applicants retain the right to present the non-elected claims 1-20 and 29-32 in a divisional application. Claims 1-32 remain pending in the instant application.

No new matter has been added by the amendments to claims 1, 8-11, 14, 16-17, 19, 21-23, 26, 28-29, and and 31 made herein. Claims 1, 8-11, 14, 16-17, 19, 21-23, 26, 28-29, and and 31 have been amended to more accurately reflect the subject matter sought in the claimed invention.

No new matter has been added by the amendment to the specification made herein.

The "Reference to Related Applications" section has been amended only to indicate that application serial number 10/713,642 is a divisional, not a continuation, of application serial number 09/727,361.

### **Request for Rejoining of Claims**

The Examiner has required an election between product and process claims.

Considering that claims 29-32 (process claims) are limited to the use of the monoclonal antibody of the elected Group IV invention (product claims), a search of these claims would encompass this specific monoclonal antibody. Applicants respectfully request that the Examiner consider rejoining claims 29-32 in the instant application, which are currently drawn to a non-elected invention (process claims), with claims 21-28 of the elected Group (product claims) under the decision in *In re Ochiai* (MPEP 2116.01), upon the Examiner's determination that the claims of the elected Group IV invention are allowable and in light of the overlapping search. If the monoclonal antibody of the elected Group IV invention (product) is found to be novel, methods (process) limited to its use should also be found novel.

### **Traversal of the Election of Species**

The Examiner asserts that Group IV is further subject to election of a single disclosed species comprising antibody conjugates wherein the conjugated moieties have different structures and functions wherein the moieties are (a) cytotoxic moieties, (b) enzymes, (c) radioactive compounds, and (d) hematogenous cells, all of claim 27.

The types of conjugates (cytotoxic moieties, enzymes, radioactive compounds and hematogenous cells) are recited in claim 27 in a Markush format.

Applicants respectfully point out that the restriction of a Markush group is proper **only** where the compounds within the group either (1) do not share a common utility, or (2) do not share a substantial structural feature disclosed as being essential to that utility (emphasis added by Applicants). MPEP 803.02

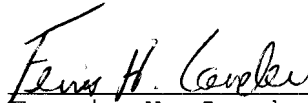
The four types of conjugates disclosed share both a common utility, i.e. treatment of a cancerous disease, and a common structural feature, i.e. each type is conjugated with the specific monoclonal antibody encoded by the clone deposited with the ATCC under accession number PTA-5690. Furthermore, utility of the treatment is dependent upon the binding of the monoclonal antibody to an antigenic moiety on the surface of a cancerous cell, i.e. the four types of conjugates share an antibody which is essential to the utility as disclosed (treatment of a cancerous disease). A search for each of the four types of conjugates clearly overlaps.

Thus, Applicants respectfully submit that this requirement for an election of species (type of conjugate as recited in claim 27) is improper and request that the Examiner reconsider the requirement.

**CONCLUSION**

Now that Applicants have fully responded to the Office Action mailed on December 27, 2006, an examination on the merits is respectfully requested.

Respectfully submitted,



Ferris H. Lander

Registration # 43,377

McHale & Slavin, P.A.  
2855 PGA Boulevard  
Palm Beach Gardens, FL 33410  
(561) 625-6575 (Voice)  
(561) 625-6572 (Fax)